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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,373	07/27/2001	Cathy S. Beyda	2001P13459US	9955
7590 08/24/2006			EXAMINER	
SIEMENS CORPORATION Intellectual Property Department 186 Wood Avenue South Iselin, NJ 08830			LE, KAREN L	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/917,373	Applicant(s) BEYDA ET AL.	
	Examiner Karen L. Le	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 16-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 13 and 16-20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The After final amendment was entered. Prosecution is reopened in light of the argument.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 13 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Warren (US 2002/0197961).

Regarding claim 13, Warren teaches a concealed telephone system (Fig 1), comprising a telephone including a keyboard and display (Fig. 1, item 32) that can make and receive telephone calls, a pair of glasses (Fig. 1, item 10), an earpiece that provide

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audio signals from the telephone to an ear of a user, said earpiece being integrated within a sidepiece of said pair of glasses (Fig. 2, item 24) and a microphone that receives voice signals from the user and provides them to the telephone (Fig. 2, item 20), wherein each of the telephone, earpiece, and microphone include short-range wireless transceiver (Fig. 1, items 22, 28 and 32) for transmitting signals therebetween (Page 3, Para. 0029).

Regarding claim 18, Warren teaches the concealed telephone system of claim 13, wherein said pair of glasses includes eyeglasses and sunglasses (Para. 0009).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warren (US 2002/0197961) in view of Kirner (DE 297 15 288 U1).

Regarding claim 16, warren does not teach concealed telephone system wherein the microphone is concealed within an article of jewelry. However, Kirner teaches concealed telephone system wherein the microphone is concealed within an article of jewelry (Title: microphone unit lies in fastener of bracelet). Warren teaches wearable

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communication devices are a hat, headband, earmuffs or another article that can be worn on a users' head. User can wear a hat and use the communications features to conveniently and privately communicate on his or her cell phone. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Kirner's feature into Warren's system in order to provide microphone being integrated within a bracelet. This feature is old and common used in telecommunication.

6. Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren (US 2002/0197961) in view of Taenzer et al (U. S. 6,438,245).

Regarding claim 17, Warren does not teach the concealed telephone of Warren, wherein the telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use. However, Taenzer teaches telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use (col. 3, lines 13-15). Taenzer teaches a two-way communication earpiece for use with a hearing aid, including a microphone for picking up sound ambient to the earpiece. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Taenzer's feature to Warren's feature to provide ambient noise picked up by the microphone when the phone is not in use. It is always useful and convenient to have this feature in telephone system.

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7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warren (US 2002/0197961) in view of Saka Shinji (JP408079875A) and further in view of Kirner (DE 29715288).

Regarding claim 19 Warren teaches a concealed telephone system, comprising: a telephone including a keyboard and display that can make and receive telephone calls (Fig. 1, item 32).

an earpiece that provides audio signals from the telephone to an ear of a user (Fig. 1, item 24), a microphone that receive voice signals from the user and provides them to the telephone (fig. 1, item 20) wherein each of the telephone, earpiece, and microphone include short-range wireless transceivers for transmitting signals therebetween (Para 0029).

Warren does not teach said microphone being integrated within said bracelet. However, Kirner teaches said microphone being integrated within said bracelet (title: microphone unit lies in fastener of bracelet and Fig. 2). Warren does not teach said earpiece being integrated within said earring. However, Saka teaches said earpiece being integrated within said earring. Warren teaches wearable communication device with clip-on member (instead of eyeglasses frame) that mount to a pair of conventional eyeglasses. Warren also teaches a microphone, a transmitter, a receiver, a speaker and a power source, all mounted to the clip-on member. Warren teaches wearable communication devices are a hat, headband, earmuffs or another article that can be worn on a users' head. User can wear a hat and use the communications features to

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conveniently and privately communicate on his or her cell phone. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Kirner's feature and Saka's feature into Warren's system in order to provide microphone being integrated within a bracelet and earpiece being integrated within an earring. This feature is old and common used in telecommunication.

8. Claim 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren (US 2002/0197961) in view of of Saka (JP408079875A) and Kirner (DE 29715288) and further in view of Taenzer et al (U. S. 6,438,245).

Regarding claim 20, Warren as modified by Saka and Kirner as suggested in the rejection above does not teach the concealed telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use. However, Taenzer teaches telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use (col. 3, lines 13-15). Taenzer teaches a two-way communication earpiece for use with a hearing aid, including a microphone for picking up sound ambient to the earpiece. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Taenzer's feature to Warren's system after modified by Saka and Kirner to provide ambient noise picked up by the microphone when the phone is not in use. This feature is very popular and convenient in telephone system.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen L. Le whose telephone number is 571-272-7487. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karen le
KLL

August 21, 2006


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